

## **REMARKS**

### ***Summary of Changes Made***

The Application was filed with 12 claims. In a preliminary amendment, all claims except claims 6 and 12 were amended. In a second amendment, claim 2 was canceled, and claims 3, 6, 8, and 10-12 were amended.

Because Amendment "C" filed 12 December 2008 was not entered into the record, this Amendment "D" is made relative to the status of the application as presented in Amendment "B," filed 28 May 2008. Applicants respectfully request that Amendment "C" not be entered in favor of the present Amendment "D," which slightly differs therefrom. Applicants believe that the Terminal Disclaimer filed together with Amendment "C" was entered into the record, and such entry is desired by Applicants.

In the Office action mailed 17 September 2008, the disclosure was again objected to due to informalities in paragraph [0061]; and apparently the form of claims 10 and 11 was objected to. Claims 1 and 3-12 were rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Claims 1 and 3-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-30 of commonly owned copending U.S. Pat. App. Pub. No. 2004/0175386, ("Yoshikawa"), in view of Nakane.

Clarifying amendments and explanations are presented herein which are believed to remedy all of the objections and rejections. Presently, claims 3-6 are canceled, and claims 1, 10 and 11 are amended. Paragraphs [0049] and [0061] are also amended. Claims 1 and 7-12 remain pending for the Examiner's consideration.

### ***Specification Objections***

Paragraph [0061] was objected to. That paragraph has been rewritten to address the Examiner's concerns. Presently, the Examiner further objects to the phrase "and so on can be listed." While it is believed that the meaning of said phrase would be clear to the average reader, the Examiner will note that this single remaining grammar issue has been corrected herein, namely, the offending phrase has been replaced with "Suitable oil components for use in the invention include, without limitation." Applicants respectfully request withdrawal of the objection.

### *Amendments to Paragraph 49*

While not covered by a rejection or objection, the Examiner will note that paragraph [0049] has been amended herein. The amendment to paragraph [0049] was rejected as new matter in the Advisory Action of 23 January 2009.

Applicants again present this amendment as well as a supporting Declaration. The amendment in paragraph [0049] corrects an erroneous translation of that paragraph. Paragraph [0031] of the priority document (JP 2004-217621) was erroneously translated to state that the lipophilic base powder may be any of "silicone resin, silicone rubber, silicone resin-covering-silicone rubber, polyamide, polymethyl methacrylate, and ethyl carbamate." Paragraph [0049] of the instant specification was the result of the erroneous translation. The new, corrected, translation of paragraph [0049] discloses that the lipophilic base powder may be any of silicone resin, silicone rubber, or silicone resin-covered-silicone rubber. The corrected translation is Appendix A to the enclosed Declaration of Mr. Yuji Iwahashi, Patent Counsel (since 1987) for Shiseido Corporation, Assignee of the present application.

Paragraph [0031] of the original Japanese priority document disclosed that a swelling lipophilic base powder could be silicone resin, silicone rubber, or silicone resin-covered-silicone rubber. Paragraph [0031] of the priority document became paragraph [0049] of the instant specification. This amendment adds no new matter.

### *Claim Objections*

It is believed that the Examiner's comment styled "SUGGESTION" may be a claim objection, or perhaps an informal guideline, relative to claims 10 and 11. In any case, the Examiner will note that claims 10 and 11 have been amended to recite, respectively, a method of treating rough skin, and a method of treating sensitive skin. Support for these limitations is found in paragraphs [0006] and [0013] of the specification, noting that the "objective [of the invention] is to provide an oily external composition for skin having an excellent rough skin recovering/preventing effect," paragraph [0006]. Further, "[t]he [ ] external composition can be used as a rough skin recovering composition and a sensitive skin caring composition," paragraph [0013]. It is apparent from this language that the composition of the invention may be used to treat rough skin or to treat sensitive skin. It is believed that such amendments meet the spirit of the Examiner's "suggestion," and render the claims clearer than would be claims

directed to a “method of applying...comprising applying...” Based on the foregoing, Applicants respectfully request withdrawal of the objection, and/or an indication that the spirit of the “suggestion” has been followed.

***Claim Rejections - (35 U.S.C. §112, 2<sup>nd</sup> paragraph)***

Claims 1 and 3-12 were rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Specifically, the Examiner contends that there is no antecedent basis in claim 1 for the limitation “wherein the covering rate of zinc oxide is....”

Initially, the Examiner will note that claims 3-6 have been canceled rendering the rejection of such claims moot. The Examiner will further note that claims 1 and 12 have been amended, in pertinent part, to recite that “the zinc oxide covers from 1 to 90% of the total surface area of said lipophilic base powder dispersed in said oil component.” It is believed that such amendment clarifies and presents the claim such that all limitations have proper antecedent basis. Applicants point out that this is merely a grammatical rewording of the claim, shown in Fig. 1 and described in paragraphs [0009], [0044]-[0048], [0053], [0073]-[0075], [0096], and Tables 3, 7, 8, and 9 for example. It is respectfully submitted that claims 1 and 12, as presently amended, are clear and definite. In view of the amendments to the claims and the clarifying explanations, it is submitted that the rejection of claims 1 and 7-12 under §112, second paragraph should now be withdrawn.

***Claim Rejections – Non Statutory Double Patenting (Yoshikawa/Nakane)***

Claims 1 and 3-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-30 of commonly owned copending U.S. Pat. App. Pub. No. 2004/0175386 (“Yoshikawa”) in view of Nakane. Although the arguments and amendments of Amendment “C” have not been entered into the record, it appears that the Terminal Disclaimer filed together therewith has been entered, and remains a part of the record.

The Terminal Disclaimer removes the Yoshikawa reference as prior art and hence makes the rejection moot.

***Claim Rejections (35 U.S.C. §102 – Nakane)***

Claims 1 and 3-12 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,122,418 to Nakane et al., (“Nakane”). Nakane relates to a composition including a complex powder including lipophilic base powder coated with zinc oxide, and an oil component. The base powder is exemplified by polymethyl methacrylate and the oil is a silicone oil. The examiner concludes that Nakane anticipates the instant claims.

The Examiner will note that claims 3-6 have been canceled thus rendering the rejection thereof moot.

Claims 1 and 12 have been amended to state that the “lipophilic base powder is one or more selected from the group consisting of silicone resin, silicone rubber, and silicone resin-covered-silicone rubber,” and that the complex powder is swelled in oil. These limitations are found in the specification at paragraph [0049] and serves to distinguish the claims from Nakane. Nakane discloses a variety of possible base powders, but fails to disclose the types of powders as presently claimed in claims 1 and 12.

The above limitations are important to distinguish the invention over Nakane. Applicants note that the Examiner cited Nakane’s Example 25 for its alleged disclosure of an oil component, which is silicone oil. However, the disclosures of Nakane generally, and of Example 25 in particular, do not correspond to the invention as instantly recited in claims 1 and 12, as amended. In particular, the silicone oil component of Example 25 does not correspond to the silicone resin and/or silicone rubber base powders instantly claimed. Further, the core powder of Nakane is not a swelling powder. As noted in paragraph 49 of the instant specification (as amended), the powders employed by Nakane, such as polyamide (nylon) and polymethyl methacrylate, are not swelling powders. Hence, Nakane fails to disclose a powder that is both lipophilic and that swells in oil.

The instantly claimed base powders, selected from silicone resin, silicone rubber, and silicone resin-covered-silicone rubber, are swellable in oil, and as such, can adsorb a plasminogen activator, as shown in Figure 1, and as disclosed in at least paragraphs [0007], [0019], and [0027] of the specification. Nakane further fails to disclose the limitation that the base powder is swelled in oil. Nakane fails to disclose that the base powder is silicone resin, silicone rubber, or silicone resin-covered- silicone rubber.

Based on the foregoing, Applicants assert the patentability of claims 1 and 12 over Nakane. Because claims 7-11 depend from claim 1, Applicants submit that they are similarly

patentable. For at least these reasons, it is submitted that claims 1 and 7-12 are not anticipated by the '418 patent to Nakane and that the present rejection must now be withdrawn.

*Conclusion*

In light of the foregoing, it is respectfully submitted that the present application, including claims 1 and 7-12, is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16057.

Respectfully submitted,

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